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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,657

05/17/2006

Olivier Casula

434299-694

9371

46188

7590

07/09/2010

Nixon Peabody LLP  
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EXAMINER

BOR, HELENE CATHERINE

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

07/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,657	<b>Applicant(s)</b> CASULA ET AL.	
	<b>Examiner</b> HELENE BOR	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***35 U.S.C. 112, 2nd Paragraph***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of Claims 1-14 under 35 U.S.C. 112, 2nd paragraph is hereby maintained.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The rejection of Claims 1-6 & 12-14 under 35 U.S.C. 102(b) as being anticipated by Bolomey et al. (US Patent No. 6,424,597) is hereby maintained.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The rejection of Claims 7-11 under 35 U.S.C. 103(a) as being unpatentable over Bolomey et al. (US Patent No. 6,424,597) as applied to claim 1-6 & 12-14 above, and further in view of Bjorner et al. (US Patent No. 5,485,263) is hereby maintained.

***Response to Arguments***

7. Applicant's arguments, see Page 8, filed 04/21/2010, with respect to the Double Patent Rejection have been fully considered and are persuasive. The Double Patent Rejection of the claims has been withdrawn.

8. Applicant's arguments filed 04/21/2010 have been fully considered but they are not persuasive. The Examiner acknowledges that the Applicant intends to invoke 35 U.S.C. 112, sixth paragraph as per the Applicant Remarks filed 12/21/2009 and 04/21/2010. However the Examiner contends that 35 U.S.C. sixth paragraph is not being invoked correctly. According to MPEP 2181, Section I:

A claim limitation will be presumed to invoke 35 USC 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitation must use the phrase "means for" or "step for";
- (B) the "means for" or "step for" must be modified by functional language;
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

9. In reviewing the amended claims, the "means for determining the position of the multiple elements relative to the object" as claimed is modifying the "means for bring the multiple elements into contact". The Claim 1 thus fails the 3-prong test and 35 U.S.C 112, sixth paragraph is not invoked. Another example, Claim 3, Lines 1-6 have structural elements, "mechanical elements", which are claimed to further modify the "the means for bring the elements into contact". As such the means in Claim 3 are being modified by sufficient structural modification and fail to meet Part C of the 3-prong analysis. Where the Applicant intends not to use 35 U.S.C. 112, sixth paragraph, the Examiner suggests avoiding the confusion resulting from "means of" or "means" language by use of terms such as "unit" instead, where appropriate.

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10. The Applicant submitted arguments that the current amended claims properly invoke 35 U.S.C. 112, sixth paragraph. The Applicant argues that the claims must be interpreted with means-plus-function format and proper reading of the corresponding structure in the specification must be taken into account. The Examiner respectfully disagrees. As explained above, 35 U.S.C. 112, sixth paragraph is not being properly invoked as the claims fail to meet Part C of the 3-prong test. *Without properly invoking 35 U.S.C. 112, Sixth Paragraph*, the claim language will be interpreted in light of the Specification but not with details from the Specification read into the claims. The Examiner contends that “means for bring the elements into contact with the surface of the object to be checked” can be broadly interpreted to read on Bolomey as disclosed in Figure 6, Element 56, which performs a similar function. The rejections are deemed proper and are hereby maintained.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELENE BOR whose telephone number is (571)272-2947. The examiner can normally be reached on M-T 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B./  
Examiner, Art Unit 3768

/Eric F Winakur/  
Primary Examiner, Art Unit 3768